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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,983	10/17/2000	Jeff S. Eder		2397

29051 7590 12/24/2003

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/688,983

Applicant(s)

EDER, JEFF S.

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 January 1991.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 23 & 70 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP § 608.01(n), Section III. However, the depending claim 23 (claim 70) recite "A computer readable medium having sequences of instructions stored therein, which when executed cause the processors in a plurality of computers connected via a network to perform the risk method of *claim 1*." Applying the infringement test, what is needed to infringe claim 23 (claim 70) is, for example, a CD-ROM having computer executable code that if and when executed would cause a computer to do the calculating, ranking and selecting steps. However, such a CD-ROM would not infringe the method steps of claim 15 since the CD-ROM itself never performs any of the active steps of calculating, ranking, and selecting required by the method. In other words, mere possession of such a CD-ROM would infringe claim 23 (claim 70), but this is not enough to infringe claim 1 (claim 47). As a result, claim 23 (claim 70) is an improper dependent claims.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-91 are rejected under 35 U.S.C. 112, first paragraph, because it is subject to undue breadth of claims. More specifically, the subject claims cover every conceivable way of using data from every conceivable systems.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of claims are vague and indefinite. More specifically it is not clear how data is being used and what "a variety of systems" include. Further, there are numerous places with informalities and lack of antecedent basis, e.g., in claim 2, line 1, ... said ... or ... the ... should be inserted before "date"; "an" before "enterprise" in claim 5, line 1 should be replaced with either ... said ... or ... the ... claim 13, "the value impact", and claim 15, "the optimal mix" do not have proper antecedent basis, same for other claims. Additionally, claims 6 and 29 "group consisting of relationships, brands, channels, and processes" are not clear, please, point out where these are defined.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, & 3-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts. The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, a non-descriptive material per se. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is not a product for performing a process, nor is it a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1, 3-22 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform the underlying process. Claims 1, 3-22 do not appear to correspond to a specific machine or manufacture, and thus encompass any product of the class configured in any manner to perform the underlying process. The claimed invention of claims 1, 3-22 also do not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 1, 3-22 are analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

See *State Street Bank & Trust Co. V. Signature Financial Group Inc.*, 47 USPQ2d 1597 (Fed. Cir. 1998) where the Federal Circuit held that: "[T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it provides "a useful, concrete and tangible result".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching (US 6,078,901) in view of Donner (US 6,263,314).

Re. Claims 1-2, 24-25, 46-48, and 71-72, Ching discloses calculating devices for non-arbitrary price determination and rational decision making and using data from a variety of systems to quantify risks associated monetary and non-monetary items for an organization (universities, banks, corporations), and obtaining reasonable input data (where data is obtained from the group consisting of advanced financial systems, basic financial systems, web site management systems, alliance management systems, brand management systems, customer relationship management systems, channel

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management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, quality control systems and purchasing systems) and networked computers each with a processor (computing devices), fair market value [Ching: see entire document particularly, Abstract; figures 3, 5, 9, 11-12, 15-16, 18-19, 23; C2 L57 to C3 L4; C4 L43 to C5 L38; C9 L66 to C12 L6; C8 L11-L32; C13 L22 to C18 L50; C39 L50 to C40 L30]. Ching, explicitly, does not disclose intangible elements (intellectual properties) and network. However, Donner discloses this item [see entire document particularly, Abstract, Figures]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine the teaching of Ching and Donner and include analysis of intellectual property by collecting pertinent data regarding an intellectual property portfolio and analyzes the collected data against empirical data to provide a qualitative and/or quantitative analysis of the intellectual property portfolio. Further, it is well known to one skill in the art of real estate, the real estate agent (mortgage company) obtains client data from verity of place such as: client application form, credit rating, bank, employer, etc. and before providing the loan, it evaluates the risk before it issuing a check to the client or his agent. Similarly, obtaining health or life insurance.

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Re. Claims 3, 26, 49 & 73, Ching discloses input data from computer keyboard [C31 L47]. Ching, explicitly, does not disclose wherein at least a portion of the data is from the Internet or external databases. However, Donner (US 6,263,314) discloses this feature [C5 L25 to C6 L61; C7 L35-L49]. It would have been obvious to modify the teaching of Ching and include obtaining portion of data from external source, as taught by Donner, to receive additional data from on-line databases from evaluation.

Re. Claims 4-5, 27-28, 50-51 and 74-75 Ching discloses wherein the organization comprises a single enterprise, a multi-enterprise organization and wherein an enterprise comprises a single product (real estate) [see claim 1 for reference].

Re. Claims 7-9, 30-32, 53-55, 76-78 Ching, explicitly, does not discloses where the risks are from the group consisting of generic risk and contingent liabilities and where generic risks are from the group consisting of fire, earthquakes, floods and weather and wherein the risks are quantified under a normal scenario or an extreme scenario. However, these are well known in insurance industries. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify teaching of Ching and include of generic risk and contingent liabilities to evaluate real estate risk component related to these group (fire, earthquakes, floods, weather, etc.) which affect the insurance policy.

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Re. Claims 10-22, 33-45, 58-69 & Ching, discloses fair market value. Ching, explicitly, does not disclose these items. However, these items are well known and used for evaluation of corporations, companies, etc (large or small) asset evaluation, liabilities, payroll (financial statements) and risk management to obtain a loan, sell stock to the public, buy/sell the company, etc.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

*US 6,278,981 to Dembo et al, Aug. 21, 2001 "Computer-implemented method and apparatus for portfolio compression", this invention discloses providing improved tools for risk management of large and/or complex portfolios of financial instruments. In accordance with particular embodiments of the invention, as described herein, a "compressed portfolio" is generated for a given target portfolio of financial instruments, stochastic optimization techniques for portfolios with options, number of simple instruments (e.g., bonds, fixed rate bonds, floating a rate notes, forward rate agreements, futures and forward contracts, foreign exchange forwards, fixed notional swaps and certificates of deposit, zero coupon bond, etc).*

*US 5,704,045 to King et al, Dec. 30, 1997 "System and method of risk transfer and risk diversification including means to assure with assurance of timely payment and segregation of the interests of capital", this invention discloses a financial management systems and, more specifically, to data processing methodology for effecting an improved capital and security structure in an insurance or other financial enterprise.*

*US 5,644,727 to Atkins, July 1, 1997 "System for the operation and management of one or more financial accounts through the use of a digital communication and computation system for exchange, investment and borrowing", this invention discloses a method and apparatus which provides an integrated financial product package together with a system of exchange, investment and borrowing that incorporates personal financial analysis, planning and management.*

*US 6,064,972 to Jankowitz et al, May 16, 2000 "Risk management technique for network access", this invention discloses risk of fraud associated with access by a subscriber to a network is managed by a system that includes a data base that stores a record for each subscriber indicative of that subscriber's usage history and payment ability for each service to which that subscriber has access. Additionally, the subscriber's record also stores an individual service risk characteristic indicative of the risk of providing access by the subscriber to a particular service, as well as a composite risk characteristic indicative of an overall risk of access.*


*US 5,191,522 to Bosco et al, Mar. 2, 1993 "Integrated group insurance information processing and reporting system based upon an enterprise-wide data structure", this invention discloses an integrated information storage processing and reporting system for processing and supervising a plurality of group insurance accounts was constructed with a single enterprise-wide relational data base. The system provides sales, underwriting, administration and actuarial functions through integrated program-controlled data processing systems specific for each function and communicating with a group insurance account data bank. Each function is accessible through a single integrated workstation.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Harish T Dass *HTD*  
Examiner  
Art Unit 3628  
12/9/2003

  
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